## REMARKS/ARGUMENTS

Applicant has carefully reviewed and considered the Office Action mailed on December 22, 2005, and the references cited therewith.

Claims 1, 3, 8, 9, 13, 16, and 17 are amended, no claims are canceled, and claim 18 is added; as a result, claims 1, 3-5, 8-9, 13, and 16-17 are now pending in this application.

Applicant respectfully submits that claim 18 does not introduce any new subject matter and are intended to cover additional claimable subject matter fully supported by the originally filed specification.

### *§ 112 Rejection of the Claims*

Claims 1, 3-5, 8-9, 13, and 16-17 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses the rejection as follows.

The Examiner states that it is unclear whether automatically "gathering, correlating, comparing, determining, adjusting, analyzing, weighting" are inherent features of "automatically" selecting a print setting of a document from the plurality of print quality settings. The Summary of the Invention in the present application begins by reciting, "The present invention provides a system and method for automatically selecting one of a plurality of print quality settings for printing a document." (Page 2, lines 25-26).

The Summary goes on to recite that the automatic method can be "broadly summarized" by: "analyzing a plurality of characteristics relating to the print request; identifying from a plurality of print settings an optimum print setting that is best suited for the plurality of characteristics; and utilizing the optimum print setting to print the document." (Page 2, lines 27-31). Subsequently described in the Summary are other embodiments of the method for automatically selecting a print setting, and a computer program for executing the method, that recite, "determining", "gathering", "comparing", "requesting", "analyzes", "identifies", "utilizes", and "determines". (Page 3, lines 1-27).

After reciting that "[t]he print quality selection logic 152 automatically selects one of a plurality of print quality settings based on data relating to document content, prior print setting selections, user input and/or one or more characteristics relating to the print request" (page 6, lines 7-10), the Detailed Description of the Invention recites at least once, in addition to the just-mentioned actions, "relating to", "printed using, "examined", "related to", "compared to", "compare", "examine", "gathers", "correlate", "collected", "identify", "use", "request", "weight", "prioritize", "weighted to", "favor", and "implementing". (Page 6, line 9, through page 12, line 1).

As such, each of the gerunds used in claims 1, 3-5, 8-9, 13, and 16-17, as amended, which the Examiner describes as being unclear as to whether they are "inherent features", are based on terms clearly recited in the specification of the present application as being "automatically" performed. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 112 rejection of claims 1, 3-5, 8-9, 13, and 16-17, as amended.

*§103 Rejection of the Claims*

Claims 1, 8, and 16 were rejected under 35 USC § 103(a) as being unpatentable over Shima (U.S. Patent No. 6,149,323), in view of Hattori (U.S. Patent No. 5,455,895). Applicant respectfully traverses the rejection as follows.

The Shima reference appears to describe a methodology for selecting one of a plurality of print settings for printing a current document. However, as the Examiner states, "[S]hima fails to teach and/or suggest the processes are performed automatically for selecting the most compatible print setting mode based upon prior print data attributes." Thus, because all of the present application's independent claims recite actions that are performed "automatically," the methodology of the present application will be compared to, and distinguished from, that of the Hattori reference.

The Hattori reference states, in column 4, lines 52-59:

> [W]hen it is determined that there is no information of an operation mode in the operation mode historical information buffer 118 (S52:YES), the latest historical information of an operation mode stored in the operation mode information buffer 118 is read (S53). Then, the operation mode corresponding to the latest historical

> information is determined as a final candidate and the program returns to the program shown in FIG. 2.

The Hattori reference goes on to state, in column 5, lines 15-19:

> [I]f any historical information read from the operation mode historical information buffer 118 at S43 is not included in the operation mode candidate(s) (S47:YES), any one of the candidates is determined as a final candidate (S49), and the program returns to the program shown in FIG. 2.

The Hattori reference appears to describe, when control codes do not correspond to a selected operation mode candidate (col. 3, lines 43-46), a chronological search program by which the operation mode corresponding to the latest historical information is determined as a final candidate, or any one of the candidates is determined as a final candidate, which appears to be a random decision. The reference does not show automatically selecting a print setting from among all the prior print settings, the selected print setting being best suited to the user's prior print setting preferences.

In contrast, Applicant's independent claims 1 and 16, as amended, each recites, "[a]utomatically selecting a print setting from the prior print settings, the selected print setting being best suited to the user's prior print setting preferences." Thus, the present application describes a methodology by which all historical document data relating to prior print setting selections are automatically compared to one or more characteristics of the current document, and a print setting from among all the prior print settings is automatically selected as being best suited to the user's prior print setting preferences.

The Merriam-Webster Online Dictionary defines "best" as "excelling all others" and "most productive of good or of advantage, utility, or satisfaction". Therefore, selecting a print setting being best suited to the user's prior print setting preferences requires that a program find a print setting "excelling all others" and "most productive of good or of advantage, utility, or satisfaction", which requires selecting a print setting from all the prior print settings, as recited in independent claim1, as amended. This differs from the operation mode corresponding to the latest historical information being determined as the final candidate, or any one of

the candidates being determined as the final candidate, seemingly randomly, as apparently described in the Hattori reference.

Independent claim 8, as amended, recites:

> automatically comparing the prior print setting selections and associated prior data document to at least one characteristic of the current document; and
>
> automatically selecting a print setting for the document based on the comparison, the selected print setting being best suited to the user's preferred print setting associated with the prior document data.

The amendments to independent claims 1, 8, and 16 shown above are supported in the specification and drawings of the present application as originally presented. Specifically, the phrase "[i]dentifying from a plurality of print settings an optimum print setting that is best suited for the user preference", or concluding with "[b]est suited for the plurality of characteristics", or "[b]est suited for the print request", and derivatives thereof, can be found on: page 2, lines 29-30; page 3, lines 3-4, lines 14-15, lines 20-21, and lines 25-26; page 6, lines 15-16; page 8, lines 8-9, and lines 23-25; page 9, lines 1-2; page 10, lines 16-18; and page 11, lines 10-13. In addition, Figure 2 recites, [I]dentify optimum print setting best suited for content characteristic", Figure 3 recites, "[I]dentify optimum print setting", Figure 4 recites, "[I]dentify optimum print setting best suited for the characteristics", and Figure 5 recites, "[U]se preference to identify optimum print setting".

As such, Applicant respectfully submits that each and every element and limitation of independent claims 1, 8, and 16, as amended, is not described, taught, or suggested in the Shima and Hattori references, either individually or in combination. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of independent claims 1, 8, and 16, as amended, as well as those claims that depend therefrom.

Claims 3-5 were rejected under 35 USC § 103(a) as being unpatentable over Shima (U.S. Patent No. 6,149,323) and Hattori (U.S. Patent No. 5,455,895), and further in view of Minagawa (U.S. Patent No. 6,614,550). Applicant respectfully traverses the rejection as follows.

Claims 3-5 depend from independent claim 1. Applicant respectfully submits that independent claim 1, as amended, is in condition for allowance in view of Shima and Hattori. From Applicant's review of the Minagawa reference, the reference does not cure the deficiencies of the Shima and Hattori references. That is, Minagawa does not teach or suggest, "[a]utomatically selecting a print setting from all the prior print settings, the selected print setting being best suited to the user's prior print setting preferences", as recited in independent claim 1, as amended.

As such, Applicant respectfully submits that each and every element and limitation of independent claim 1, as amended, is not described, taught or suggested by the Shima, Hattori, and Minagawa references, either individually or in combination. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of dependent claims 3-5.

Applicant has amended dependent claim 3 by substituting the word "favoring" for "adjusting" because the verb "to favor" is used in the specification of the present application as originally presented. (Page 10, lines 25 and 28).

Claims 9, 13, and 17 were rejected under 35 USC § 103(a) as being unpatentable over Shima (U.S. Patent No. 6,149,323), Leiman et al. (U.S. Patent No. 6,469,796), and further in view of Hattori (U.S. Patent No. 5,455,895). Applicant respectfully traverses the rejection as follows.

With regard to independent claim 9, as amended, the Examiner cites the Shima reference as describing the plurality of characteristics, including "[a] host device type (name of the machine, col. 3, lines 20-25)". Referring to figures 5 and 6, the reference states, "[a] plurality of host computers 61A, 61B are arranged so as to be able to communicate with one printer 65 via a network 63." (Col. 6, lines 1-3). The reference appears to describe a multiple computers connected by a network that are differentiated by designations, which may be alternatively termed "the name of the machine". The reference does not show a plurality of characteristics including a host device type. Moreover, neither Shima, Leiman, nor Hattori show a plurality of characteristics including a type of text data, a type of image data, an infrared communication, and a radio frequency communication.

In contrast, Applicant's independent claim 9, as amended, recites:

> automatically analyzing a plurality of characteristics relating to document data in the current document, the plurality of characteristics including a host device type, a type of text data, a type of image data, an infrared communication, and a radio frequency communication.

The specification of the present application as originally presented distinguishes "a host device type" from "the name of the machine" by defining the type "[a]s a PC, laptop, or digital appliance". (Page 9, lines 10-11). The specification goes on to describe the difference between host device types by reciting:

> [I]f the host device is a PC, then the logic 152 may select a higher print quality setting under the assumption that the PC has a relatively fast processor to process the print job without significant delay. Alternatively, if the host device is a digital appliance, then the logic 152 may select a lower print quality setting under the assumption that the appliance has a slower processor that is better suited for processing less computationally intense print requests.

The amendment to independent claim 9 shown above is supported in the specification of the present application as originally presented. Specifically, "[a] type of text data and/or image data in the document" can be found on page 8, lines 16-17, of the specification. The effect of these characteristics on print settings is described by a detailed recitation in the specification. (Page 7, line 23, through page 8, line 2). An "[i]nfrared or RF [radio frequency] communication" can be found on page 9, lines 9-10, of the specification.

Independent claim 17, as amended, recites:

> automatically analyzing a plurality of characteristics relating to document data in the current document, the plurality of characteristics including a host device type, a type of text data, a type of image data, an infrared communication, and a radio frequency communication.

As such, Applicant respectfully submits that each and every element and limitation in independent claims 9 and 17, as amended, is not described, taught, or suggested in the Shima, Leiman, and Hattori references, either individually or in combination. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of independent claims 9 and 17, as amended.

Dependent claim 13 has been amended to distinguish the word "setting" from usage of "print setting" by preceding setting with the adjective "physical" in order to denote a location or situation in which the printer is being used. Such an amendment is supported by the specification as originally presented. The specification recites, on page 10, lines 2-8:

> [I]f the printer is being used in a home setting where digital photographs are printed frequently, then print requests for documents containing .gif data may be heavily weighted to using a Best print quality. However, if the printer is being used in an office setting where .gif images are printed frequently, then print requests fro documents containing .gif image data may be weighted to using a Normal print quality.

Neither Shima, Leiman, nor Hattori show a plurality of characteristics including "[a] physical setting in which the printer is being used."

As such, Applicant respectfully submits that each and every element and limitation in dependent claim 13, as amended, is not described, taught, or suggested in the Shima, Leiman, and Hattori references, either individually or in combination. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103 rejection of dependent claim 13, as amended.

## CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney Matthew L. Wade at (208) 396-5263 to facilitate prosecution of this matter.

At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

**CERTIFICATE UNDER 37 CFR §1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: **MS AMENDMENT** Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 1st day of March, 2006.

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